

REMARKS

Claims 12-21 are pending in the present application. In the Office Action, claims 12-21 were rejected under 35 U.S.C. § 103(a) as allegedly being anticipated by Wiedemer (U.S. Patent No. 5,155,680) in view of Pearce (U.S. Patent No. 5,805,880). The Examiner's rejections are respectfully traversed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. That is, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. Third, there must be a reasonable expectation of success. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. A recent Federal Circuit case emphasizes that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based

upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 143 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

Wiedemer is directed to a computer software security and billing system. In particular, Wiedemer describes a security module and a billing module that may be installed in a personal computer. However, as admitted by the Examiner, Wiedemer is completely silent with regard to System Management Mode. Accordingly, Wiedemer fails to teach or suggest calling an SMM exit routine, as set forth in claims 12 and 15-16. Pearce describes techniques for allowing essential utility programs, such as essential maintenance operations that precondition or maintain system hardware, to avoid security measures of an operating system while otherwise retaining security operation. In one embodiment, the essential utility routine accesses a protected computer system by making a call to a system management mode program running on a host processor. See Pearce, col. 1, ll. 8-64.

The Examiner alleges that it would have been obvious to combine the teachings of Wiedemer and Pearce to arrive at the invention set forth in claims 12-21. Applicant respectfully disagrees. Pearce suggests allowing essential utility programs to avoid the security measures of an operating system by invoking a system management mode program. However, Pearce defines essential utility programs as programs that are used to precondition or maintain system hardware. The security and/or billing modules described by Wiedemer are not used to precondition or maintain system hardware and therefore are not essential utility programs. Thus, the cited references fail to provide any suggestion or motivation for combining Wiedemer and Pearce to arrive at the claimed invention. In particular, the cited references fail to provide any suggestion or motivation for allowing the security and/or billing modules described by Wiedemer to access

and/or utilize portions of the computing system (such as memory locations) that may only be accessed when the computing system is in the system management mode.

To the contrary, Applicant respectfully submits that a person of ordinary skill in the art would not combine Wiedemer and Pearce in the manner suggested by the Examiner. As discussed above, Pearce teaches that in some cases essential utility programs may be allowed to avoid the security features imposed by the operating system. However, Applicant respectfully submits that a person of ordinary skill in the art would not be motivated by the teachings of Pearce to allow the security and/or billing modules described in Wiedemer to utilize the system management mode to bypass the security features of the operating system because these are not essential utility programs. Accordingly, the security features of the operating system should not be bypassed, overridden, or otherwise avoided by the security and/or billing modules described in Wiedemer.


For at least the aforementioned reasons, Applicant respectfully submits that the Examiner has failed to make a *prima facie* case that the present invention is obvious over Wiedemer and Pearce, either alone or in combination. Applicant requests that the Examiner's rejections of claims 12-21 under 35 U.S.C. 103(a) be withdrawn.

For the aforementioned reasons, it is respectfully submitted that all claims pending in the present application are in condition for allowance. The Examiner is invited to contact the undersigned at (713) 934-4052 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

Date: _____

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